

PATENT

App. Ser. No.: 10/691,415
Atty. Dkt. No. ROC920030261US1
PS Ref. No.: IBMK30261

REMARKS

This is intended as a full and complete response to the Final Office Action dated October 19, 2006, having a shortened statutory period for response set to expire on January 19, 2007. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-25 are pending in the application. Claims 15-17 and 23-25 have been canceled. Thus, claims 1-14 and 18-22 remain pending following entry of this response. Applicants submit that the amendments presented herein do not introduce new matter.

Claim Rejections - 35 U.S.C. § 112

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 has been canceled. Accordingly, Applicants request withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,940,821 to *Wical*. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Page 6

757941781.1.doc

PATENT

App. Ser. No.: 10/691,415
Atty. Dkt. No. ROC920030261US1
PS Ref. No.: IBMK30261

In this case, *Wical* fails to teach each and every element in the claims. As a first example, despite Applicants arguments submitted with the response to the previous Office Action (dated April 27, 2006), *Wical* fails to teach a pointer to a set of expanded search terms, as recited in independent claim 1. Links or cross-references between categories described in *Wical* do not point to a set of expanded terms. Further, while there is no teaching of storing queries at all (despite the Examiner's reference to the Abstract), much less *storing a query and information related to the pointer* as recited in the claim.

Accordingly, Applicants respectfully submit claim 1, as well as its dependents, are allowable and respectfully request withdrawal of this rejection.

Claims 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,493,721 to *Getchius*. Claims 23-25 have been cancelled. Regarding the remaining claims, Applicants respectfully traverse these rejections.

Applicants respectfully submit that *Getchius* fails to teach each and every element in the claims. For example, regarding claim 18, Applicants respectfully submit that there is no teaching of an interface "allowing the user to specify a set of expanded search terms to be associated with the at least one base search term and further *allowing the user to specify whether the set of expanded search terms should be dynamically linked with the query via a pointer used to identify a source of the set of expanded search terms*" as recited in the claim. While *Getchius* does teach some use of expanded search terms, there is certainly no teaching of dynamically linking a set of search terms with a query, in the manner claimed.

Accordingly, Applicants respectfully submit claim 18, as well as its dependents, are allowable and respectfully request withdrawal of this rejection.

PATENT

App. Ser. No.: 10/691,415
Atty. Dkt. No. ROC920030261US1
PS Ref. No.: IBMK30261

Claim Rejections - 35 U.S.C. § 103

Claims 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wical* in view of *Getchius*. Claim 4 depends from claim 1 which, Applicants submit is allowable for reasons described above. Accordingly, Applicants submit claim 4 is also allowable. Regarding the remaining claims, Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criterion. For example, even if combined as suggested in the Office Action, the reference fail to teach "obtaining one or more parameters indicative of a state of an environment in which the query is to be executed" and "obtaining, based on the one or more parameters and the base search term, one or more expanded search terms" as recited in independent claim 5.

The Examiner concedes these claim limitations are not taught in *Wical*, but refers to column 5, lines 22-23 of *Getchius*, as teaching "workload process" which may be properly interpreted as a parameter indicative of an environment. Applicants respectfully submit, however, that even if a parameter indicative of an environment is described in the cited section, there is no teaching in the cited portion, nor anywhere else in either of these references, that a set of search terms is obtained based on a parameter indicative of the environment, as recited in the claim.

PATENT

App. Ser. No.: 10/691,415
Atty. Dkt. No. ROC920030261US1
PS Ref. No.: IBMK30261

Accordingly, Applicants respectfully submit claim 5, as well as its dependents, are allowable and respectfully request withdrawal of this rejection.

Claims 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Getchius in view of U.S. Pat. No. 6,999,959 to *Lawrence et al.* These claims have been canceled, however, rendering this rejection moot.

Page 9

757941781.1.doc

PATENT

App. Ser. No.: 10/691,415
Atty. Dkt. No. ROC920030261US1
PS Ref. No.: IBMK30261

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Randol W. Read, Reg. No. 43,876/

Randol W. Read
Registration No. 43,876
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants